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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/743,826 | 02/27/2001 | Ronald Peter W. Kesselmans | 294-96 PCT/U | 8612 |

23869 7590 06/27/2003

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| EXAMINER |
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WHITE, EVERETT NMN

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| ART UNIT | PAPER NUMBER |
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1623

DATE MAILED: 06/27/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/743,826

Applicant(s)

KESSELMANS ET AL.

Examiner

EVERETT WHITE

Art Unit

1623

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 June 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 16 June 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

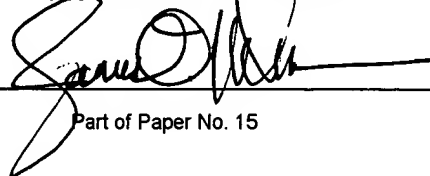
3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the _____ application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.Claim(s) objected to: None.Claim(s) rejected: 15-21 and 27-31.Claim(s) withdrawn from consideration: None.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600



Continuation of 5. does NOT place the application in condition for allowance because: of the the reasons set forth in the Office Actions of record. In Applicants Amendment filed June 16, 2003, Applicants argue against the rejection of the claims on the grounds that the claimed process for oxidizing a starch requires significantly less oxidizing agent than processes of the prior art. However, this argument is not persuasive since no specific amount of oxidizing agent has been set forth in the instant claims. Applicants argue against the rejection of the process claims on the grounds that the Whitaker and Just patents disclose using alkaline conditions during the oxidation process which is in contrast to subjecting the oxidized starch product obtained in step 1 of the instant claims to alkaline treatment. The argument is not persuasive since the Just patent clearly discloses in Example 1 thereof that after the sodium hypochlorite addition was completed, the pH was maintained by incremental sodium hydroxide addition, which embraces step 2 of the instant claims which involves subjecting the oxidized starch product to an alkaline treatment. Applicants further argue against the rejection of the claims over the product claims on the ground that the references used to reject the claims do not disclose the two-step claimed process. However, tis argument is not persuasive since process limitations cannot impart patentability to a product that is not patentably distinguished over the prior art. In re Thorpe et al. (CAFC 1985), supra; In re Dike (CCPA 1968) 394 F2d 584, 157 USPQ 581; Tri-Wall Containers, Inc. v. United States et al. (Ct Cls 1969) 408 F2d 748, 161 USPQ 116; In re Brown et al. (CCPA 1972) 450 F2d 531, 173 USPQ 685; Ex parte Edwards et al. (BPAI 1986) 231 USPQ 981. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., amount of carboxyl groups and amount of oxidizing agent) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).